

REMARKS

The Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Formal Matters

Claims 11 and 19 have been canceled.

Claims 9 and 12 have been amended for clarity. Support for these amendments may be found in the Claims as originally presented and throughout the specification. Support for Claim 12 can be found, for example, in the specification on pages 16-17, paragraphs 40-41.

Claim 21 has been amended to change its dependency due to the cancellation of claim 19.

As the above amendments introduce no new matter, entry of these amendments by the Examiner is respectfully requested.

Claim Rejections – 35 USC §112

Claim 9 is rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office alleges that there is insufficient antecedent basis for "said printheads" in claim 9 because the previous claims do not positively recite that more than one printhead is required.

Applicants have amended claim 9 to recite "said printhead", which has sufficient antecedent basis support.

In light of this amendment, applicants respectfully request withdrawal of this rejection.

Claim Objections – 37 CFR 1.75

Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 17.

While not agreeing with the veracity of the Examiner's rejection, the Applicants have canceled claim 19 to expedite prosecution of the subject application,

rendering this objection moot.

Withdrawal of this objection is thus respectfully requested.

Claim Objections – 37 CFR 1.75(c)

Claims 11-16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office alleges that claim 11, which claims "a biopolymer array" produced according to the method of the claimed invention, does not possess any structural distinctions between the prior art and the claimed apparatus.

In response, the Applicants have canceled claim 11 and amended claim 12 to remove its reference to the array "according to claim 11" and add the element of "producing a biopolymer array according to the method of claim 9". Claims 13-16 remain unchanged. Applicants submit that these amendments render the claims of proper dependent form.

In light of these amendments, withdrawal of this objection is respectfully requested.

Claim Rejections – 35 USC §102

Claims 1-10, 12-17 and 21 are again rejected under 35 U.S.C. §102(e) as being anticipated by Shchegrova et al. (U.S. 2003/0143329).

Specifically, the Office alleges that Shchegrova et al. discloses a "method, apparatus, and computer program products useful in fabricating chemical biopolymer arrays" which anticipates the claimed invention.

For a rejection of claims under §102 to be properly founded, the Office must establish that a single prior art reference either expressly or inherently discloses each and every element of the claimed invention. See, e.g. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In *Scripps Clinic & Research Found. v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991), the Federal Circuit held that:

"Invalidity for anticipation requires that **all of the**

elements and limitations of the claim are found within a single prior art reference.... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Id.* at 1010.

Anticipation cannot be found, therefore, unless a cited reference discloses all of the elements, features or limitations of the presently claimed invention. Applicants respectfully submit that Shchegrova et al. fails to recite all of the elements of claims 1-10, 12-17 and 21.

The Office alleges that the Applicants' previous arguments are not persuasive. The Office asserts that a frame as discussed in Shchegrova can be considered a printhead assembly according to the claimed invention because "the frames of Shchegrova include dispensers (printheads), as such the frame may be considered a printhead assembly". (Office Action mailed October 9, 2008 at page 2, paragraph 2)

The Applicants respectfully disagree. In the quote above, the Office asserts that dispensers of Shchegrova are the same as printheads as claimed. A frame as discussed in Shchegrova, is "a series of dispensers which can simultaneously move along selected paths". Selecting a "frame", as defined by Shchegrova is selecting a subset of nozzles on a particular printhead. In contrast, selecting a printhead assembly according to the claimed methods requires selecting an entire printhead or printheads (i.e., the sum of all printheads on the writer), the definition of which is recited in paragraph 45 of the specification, which reads:

"As to the subject methodology itself, it involves a set of criteria defining an 'Aggregation Hierarchy'. In the subject model's hierarchy, there exists a 'Printhead Assembly', as represented by Fig. 3. **The Assembly 100 corresponds to the sum of all printheads on a writer.** The Printhead Assembly is made up of one or more 'Printhead Groups' 102, each of which can print a complete set of the fluids to be dispensed by the writer. Each Printhead Group is made up of one or more 'Printheads' 104, each of which object can be made to fire at a specific point along the travel of

the substrate. Each Printhead is made of up of one or more 'Wells' 108, each of which contains exactly one of the fluids to be printed. Each Well is made up of one or more 'Nozzle Regions' 110, which are distinct from each other by their physical separation along one axis or by the way they are fired. Each Nozzle Region is made up of one or more 'Nozzles' 112, which is the smallest addressable unit of the printhead."

Therefore, because selection of a frame in Shchegrova requires selecting a subset of nozzles on a particular printhead for use in a particular printing operation, it cannot read on selecting an entire printhead (or "the sum of all printheads on a writer") as is currently claimed.

The Office also asserts that Shchegrova teaches the step of entering printhead-related data, stating:

It should be noted that the step only requires data from one of the parameters of the group. One broad parameter is 'type' of printhead. The 'best non-error' dispenser is a 'type' of dispenser that is distinguished from other dispensers.

(Office Action mailed October 9, 2008 at page 2, paragraph 4)

The Applicants respectfully disagree. The Applicants submit that a "best non-error dispenser" as defined in Shchegrova is distinct from a "type of printhead" as claimed. Shchegrova distinguishes between "type of dispensers" based on the performance (i.e., error vs. non-error) of a particular subset of nozzles. In contrast, a "type of printhead" as claimed is not related to the performance of a particular nozzle (i.e., error or non-error). Rather, by "type of printhead" is meant to specify a mechanism of action of a printhead (e.g., piezo or thermal based printhead, as noted in the specification on page 21, paragraph 50). As such, the Applicants submit that identifying a "non-error" dispenser is not equivalent to entering a "type of printhead" as asserted by the Examiner.

Accordingly, because Shchegrova fails to teach each and every element of claims 1-21, the Applicants respectfully request the withdrawal of this rejection.

CONCLUSION

In view of the amendments and remarks above, Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Office finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030938-1.

Respectfully submitted,

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